

**REMARKS**

This amendment, submitted in response to the Office Action dated March 26, 2002, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

As a preliminary matter, Applicant would request that the finality of the Office Action be withdrawn. The Examiner maintains that a first Office Action final rejection is warranted in this case, because the claims are drawn to the same invention claimed in the earlier application. However, Applicant would submit that by the Preliminary Amendment filed on March 14, 2002, the claimed invention was modified to include additional subject matter. Had a preliminary amendment not been filed, then arguably the first Office Action final rejection would be appropriate. However, that is not the case in the present application. Accordingly, the finality of the Office Action should be withdrawn.

Turning to the merits of the Office Action, claims 1-2, 4-5, 12/1-2, 12/4-5 and 17 remain pending in the application. Claims 1 and 12/1 have been rejected under 35 U.S.C. Section 103 as being unpatentable over Takanashi in view of Michelson (both previously of record). Claims 2, 4-5, 12/2/1 and 12/5/1 have been rejected under 35 U.S.C. Section 103 as being unpatentable over Takanashi in view of Michelson and further in view of Fujimura (previously of record). Claims 2 and 17 have been rejected under 35 U.S.C. Section 103 as being unpatentable over Takanashi in view of Michelson and further in view of Koguchi (previously of record). Applicant submits the following arguments in traversal of the art rejections.

Applicant's invention relates to an image forming method. Detailed descriptions of the background and exemplary embodiment of the invention are set forth in the August 4, 2000

Amendment at pages 6-7. Similarly, Fujimura is described in the August 4 Amendment at page 7. Takanashi is described in the April 23, 2001 Amendment at pages 3-4. Michelson and Koguchi are described in the January 14, 2002 Amendment at pages 3-4. Applicant refers the Examiner to these descriptions.

The Examiner maintains that the combination of Takanashi and Michelson teaches or suggests each feature of claim 1. Applicant would maintain that the rejection is not supported for the following reasons, despite the Examiner's arguments to the contrary set forth in the Advisory Action of February 4, 2002.

First, the Examiner asserts that the binder (of Takanashi) would necessarily obstruct vacuum holes in the combination of Takanashi and Michelson. Advisory Action, page 3, lines 2-4. Despite the Examiner's characterization to the contrary, this actually supports Applicant's prior arguments that it would not be possible to combine the teachings of Takanashi and Michelson without significant re-design of both references in ways that are not contemplated in the art. Regardless of whether the rejection is a modification of Takanashi in view of Michelson, or vice versa, their combination is improper.

Fundamentally, the placement of the binder onto the receiving sheet in Takanashi and the subsequent heating of a coloring material onto the receiving sheet surface all rely on particular placements of the binder and the rolled colored material relative to the drum. The binder is provided by relaying out a continuous roll of material, while applying tension with the fuser element 6. Similarly, the continuous roll of the color material is provided to a surface of the binder material under tension. There is no indication of how an individual toner sheet could be adequately positioned against the binder absent the use of the continuous roll of the toner.

To the extent that the Examiner relies on Michelson to teach individual toner sheets, one skilled in the art is still left to consider how to keep the toner sheet disposed against the binder (Takanashi, element 4b) during the transfer. In this connection, Michelson teaches that the contact of the toner to its underlying target is by suction. However, as previously discussed, it would not be possible to provide the relative positioning of the toner sheet by suctioning in the cited combination, because in Takanashi, the underlying binder material (formed as a continuous roll), would not permit an overlap of the toner sheet over an edge of the binder material that would allow suction to be used as a positioning mechanism.

As a related matter, the Examiner contends that there is no contact between the drum and binder sheet in Takanashi, and therefore, there is no obstruction of vacuum holes by the binder. Advisory Action, page 3, lines 5-11. The obstruction of suction by the binder does not require direct contact between the binder and the drum as the Examiner suggests. Rather, all that is required is that the binder be intermediate to the drum and the toner, which is the case when the Examiner attempts to combine Takanashi and Michelson.

The remaining claims are patentable for the reasons of record. Moreover, Applicant would maintain that claim 1 is generic to all pending claims, which would warrant rejoinder of any non-elected claims in the present application.

Applicant has added claim 18 to describe that attachment of the image receiving sheet comprises adhering the image receiving layer to the whole recording region of the recording paper simultaneously. This feature is shown in Fig. 6 of the application, for example. Applicant would submit that the Amendment should be entered as a matter of the course since the finality of the Office Action is premature. The new claim describes that the image receiving layer is

provided to a whole recording region of the recording paper at the same time. By contrast, the positioning of the recording and transfer sheet in Takanashi is not provided to a whole recording region simultaneously. Fig. 1 clearly illustrates that any given time, the contact between the recording material 3 and the image receiving material 4b is incomplete, and thus does not comprise forming a contact to the whole recording region at the same time. Michelson does not include an image forming layer in addition to the receiving material, and thus does not make up for this deficiency of the primary reference.

Applicant has added claim 19 to describe that the image receiving layer is provided in a sheet. This is supported by the specification at page 11, line 15, for example. In Takanashi, the image receiving layer is provided as a roll.

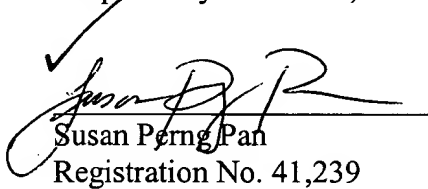
Applicant has added claim 20 to describe the attachment of the recording material to the drum using suction, and claim 21 to describe that the respective layers are each disposed on an outer circumferential surface of the drum.

In view of the above, Applicant submits that claims 1-2, 4-5, 12/1-2, 12/4-5 and 17-21 are in condition for allowance. Therefore it is respectfully requested that the subject application be passed to issue at the earliest possible time. The Examiner is requested to contact the undersigned at the

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/337,667

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Susan Perng Pan  
Registration No. 41,239

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

Date: June 25, 2002

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/337,667

**APPENDIX**

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**



**Claims 18-21 are added as new claims.**